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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,821	07/15/2003	Rodney Craig MacAulay	0641-0250P	5924

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,821

Applicant(s)

MACAULAY ET AL.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

1. Applicant's election with traverse of the species of Figs. 1-10 in the reply filed on February 11, 2005 is acknowledged. The traversal is on the ground(s) that: (a) the Office action fails to provide any evidence that the identified species are both independent and distinct; (b) the assertions needed to properly allege that Applicants are claiming independent and distinct species are not made; (c) the claims are not mutually exclusive; and (d) the Examiner can examine claims 1-19 without undue burden. This is not found persuasive because of the reasons, *inter alia*, set forth below:

(a) the Examiner respectfully submits that the previous Office action did provide evidence that the identified species are both independent and distinct as seen in the Examiner's identification of the species of Figs. 1- 10 and the species of Fig. 11 in accordance with MPEP 809.02(a). More importantly, Applicant apparently concedes that the identified species are independent and distinct as evidenced by the fact that applicant did not submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. See page 2 of the restriction on January 27, 2005;

(b) the assertions needed to properly allege that Applicants are claiming independent and distinct species are plainly made in the restriction requirement. Indeed, the first sentence of the restriction mailed on January 27, 2005 clearly stated "This application contains claims directed to the following *patentably distinct species* of the claimed invention: the species of Figs. 1- 10 and the species of Fig. 11." (Emphasis added);

(c) Applicant's statement that the claims are not mutually exclusive is in direct conflict with Applicant's own listing of the claims that are read on the elected species. In fact, Applicant's response states: "claims 1, 2 and 7-19 read on the elected species; and that claims 3-

8 read on the non-elected species.” In other words, Applicant apparently admits that claim 3 recites the limitations such as “that opening being in the form of an elongate slot extending longitudinally along the housing at the second end” which under the disclosure are found in the species of Fig. 11 but not in the species of Figs. 1-10. Put in another fashion, claims 3-8 recite the mutually exclusive characteristics such as the elongate slot 120 that renders the species of Fig. 11 to be patentably distinct from the species of Figs. 1-10; and

(d) the mutually exclusive characteristics set forth in the claims render undue burden to search all claims 1-19 even if these claims are searchable and classifiable in the same classes and subclasses in the US Patent Classification System. It is well settled that for the restriction requirement of species, it is not necessary to show a separate status in the art or separate classification. MPEP 808.01(a).

For the foregoing reasons, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 11, 2005.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"

and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the abstract: (a) exceeds 150 words; and (b) uses the legal phraseology "means." Correction is required. See MPEP § 608.01(b).
5. The drawings are objected to because each part of the invention such as: (a) the lateral bore in claim 6 and line 32 on page 17 of the specification; and (b) the key, keyway, or splined coupling in claims 9 and 10 should be designated by a referential numeral or character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as: (a) the lateral bore in claim 6; and (b) the key, keyway, or splined coupling in claims 9 and 10 must be shown or the features canceled from the claims. *No new matter should be entered.*

7. The disclosure is objected to because of the following informalities: each part of the invention such as: (a) the lateral bore in claim 6 and line 32 on page 17 of the specification; and (b) the key, keyway, or splined coupling in claims 9 and 10 should be designated by a referential numeral or character. Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter such as “a longitudinal slot” in claim 15. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

9. Claims 8, 9, 18, and 19 are objected to because of the following informalities: (a) no antecedent basis is seen for the terms such as “the coupling” in claim 8, “the first and second *section*” in claim 18, and “said abutment means” and “the tab” in claim 19; and (b) the claims contain grammatical or typographical errors, e.g., “the first and second *section*” in claim 18 should have been “the first and second *sections*” (plural, emphasis). Appropriate correction is required.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims the key, keyway, or splined coupling in claims 9 and 10. However, the drawings do not show these claimed features. It is unclear as to how the claimed key, keyway, or splined coupling are interconnected with other structural elements. In other words, claims 9 and 10 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1, 2, and 7-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms such as “connectable” and “rotatable” in claims 1 and 2, “movable” in claim 9, and “receivable” in claim 17 are vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, in claims 1 and 2, the actuator is connectable, but is not required structurally to be connected to the adjusting device. See “crimpable” and “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “removable” in *In*

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re Burke Inc., 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

It is unclear:

(a) whether a confusing variety of terms such as: (a) “a device” and “an adjustable device” in claim 1; and (b) “an end of a cable of a Bowden cable system” in claim 2 and “a suitably shaped termination of the sleeve of the Bowden system” in claim 16 refer to the same or different things. See MPEP 608.01(o) and 2173.05(o). Applicant is respectfully urged to identify each claimed element with reference to Figs. 1-10; and

(b) which structures define the limitations such as: (a) the lateral bore in claim 6; and (b) the key, keyway, or splined coupling in claims 9 and 10. Applicant is respectfully urged to identify each claimed element with reference to Figs. 1-10.

It is unclear the term “the second” in the recitation “the second nut are moved towards the second to respective limiting positions” in claim 18 refers to what feature.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 7-11, 18, and 19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Darbyshire (US Patent No. 5,797,652 cited by Applicant).

Regarding claim 1, Darbyshire teaches an actuator 3 connectable to and for adjusting a device 2, wherein the actuator 3 comprises:

a housing 24 having a longitudinal passage extending between a first end (see

Attachment) and a second end (Att.) of the housing 24 and defining an opening at or adjacent to the second end;

a spindle 10 supported in the housing 24 and movable longitudinally in the housing passage, the spindle 10 having two oppositely handed, longitudinally spaced threaded portions (right and left hands) 12 and 13 of which a first threaded portion 12 is (radially) nearer to the first end and a second threaded portion 13 is (axially) nearer to the second end (id., col. 3, lines 44-57);

a first threaded nut 15 fixed relative to the housing 24 and threadedly engaged with the first threaded portion 12 of the spindle 10;

a handle 8 rotatably mounted at the first end of the housing 24, the handle 8 being coupled to the spindle 10 for rotating the spindle 10 in the first nut 15 and thereby moving the spindle 10 longitudinally relative to the first nut 15 and the housing 24;

a second nut 11 fixed against rotation relative to the housing 24 (id., col. 4, lines 19-29) and threadedly engaged with the second threaded portion 13 of the spindle 10, whereby in response to rotation of the spindle 10 by the handle 8, the second nut 11 is movable longitudinally in the housing passage relative to the spindle 10, in the same direction as movement of the spindle 10 relative to the housing 24; and

connecting means 23, 25 on or of the second nut 11 and connectable, through the opening defined by the housing 24, to an adjustable device 2 to be adjusted by the actuator 3;

wherein the spindle 10 is rotatable by the handle 8 for adjusting the adjustable device 2 by longitudinal movement in the same direction of the spindle 10 relative to the housing 24 and of the second nut 11 relative to the spindle 10.

Regarding claim 7, each threaded portion 12 or 13 has a thread of a substantially common pitch (right or left hand pitch) as seen in Figs. 2 and 3. *Id.*, col. 3, lines 44-57.

Regarding claim 8, the handle 8 is mounted on the housing 24 and held thereon against longitudinal movement relative to the housing 24, and wherein the coupling 16, 17 between the handle 8 and the spindle 10 enables the spindle 10 to adjust longitudinally relative to the handle 8 as the spindle 10 moves longitudinally with respect to the housing 24.

Regarding claim 9, an end portion of the spindle 10 at the first end of the housing 24 is movable longitudinally within a sleeve 16, 18 defined by the handle 8, and wherein there is a key and keyway or splined coupling between the sleeve 16, 18 of the handle 8 and the spindle 10. *Id.*, col. 3, line 58 through col. 4, line 18.

Regarding claim 10, the first nut 15 is held against rotation by a key and keyway engagement with the housing 24. The key and keyway engagement are defined by a lateral projection slidably located in a slot or groove (not shown) as described in col. 4, lines 25-29.

Regarding claim 11, the first nut 15 is held against movement longitudinally of the housing 24 by being located between a shoulder 6 and at least one tab 19, and wherein the shoulder 6 is defined by the housing 24 and faces towards the first end (Att.) and the at least one tab 19 is formed integrally with the housing 24 and protruding resiliently into the passage.

Regarding claim 18, the spindle 10 has an unthreaded part 17 of its length between adjacent ends to the threads of the first and second sections 12 and 13, with said unthreaded part 17 having abutment means 27 for providing a sharply defined stop when the spindle 10 and the second nut 11 are moved towards the second to respective limiting positions. *Id.*, col. 4, line 64 through col. 5, line 3.

Regarding claim 19, said abutment means 27 is provided by a lateral tab 17 projecting from the spindle 10, with the tab 17 having a leading face (Att.) in the direction of rotation of the spindle 10 for movement towards the second end, and the abutment means 27 is adapted to stop rotation of the spindle 10 by said abutment face 27 abutting a surface defined by the housing 24. Id., col. 4, line 64 through col. 5, line 3.

16. Claims 2, 12-14, 16, and 17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

17. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Heuberger et al. (handle 9), Gabas et al. (nuts 93 and 94), Harrison et al. (nut 85), and Schuster (handle in Fig. 7).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

April 4, 2005

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong
Primary Examiner

ATTACHMENT

